

REPLY, March 26, 2003
U.S. Serial No. 09/924,981

REMARKS

Continued prosecution and reconsideration of the above-identified application is respectfully requested in view of the Terminal Disclaimer and the discussion that follows.

Claims 1-28 are in the case and are before the Examiner.

I. The Rejections

1. Double Patenting

A. Claims 1-23 and 26-28 stand rejected as being allegedly obvious under the judicially created doctrine of obviousness-type double patenting over claims 1-152 of U.S. Patent No. 6,235,480 B1, in view of the disclosures of U.S. Patent 5,401,837 (Nelson, issued March 28, 1995).

The present Reply is accompanied by a terminal disclaimer over U.S. Patent No. 6,235,480 B1 obviates the non-statutory double patenting rejection to prevent possible harassment by multiple assignees. There is no need to prevent alleged improper time-wise extension of the "right to exclude", because the patent term is already tied to the earlier filing date.

As noted on the filing receipt of the subject patent application, the present application is a continuation-in-part of U.S. Serial No. 09/788,847, filed February 20, 2001, which is a division of U.S. Serial No. 09/406,064, now U.S. Patent No. 6,270,973 filed September 27, 1999, which is a continuation-in-

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part of U.S. Serial No. 09/358,972, now U.S. Patent No. 6,235,480 B1, the primary reference cited above, which is a continuation-in-part of U.S. Patent No. 09/252,436, now U.S. Patent No. 6,159,693, which is a continuation-in-part of U.S. Patent No. 09/042,287, now U.S. Patent No. 6,335,162. The present application is entitled to the benefit of the priority filing date of those earlier-filed patent applications.

For the convenience of the Examiner, the patent applications stemming from the first-filed application, U.S. Serial No. 09/042,287 filed March 13, 1998, is summarized. U.S.S.N. 09/757,132 (now U.S.P.N. 6,379,898) is a continuation of 09/042,287, prosecuting the restricted, therefore patentably distinct claims. U.S.S.N. 09/252,436 (now U.S.P.N. 6,159,693) is a continuation-in-part of 09/042,287. The claims restricted from that application were carried forward into co-pending U.S.S.N. 09/790,417 and U.S.S.N. 09/790,457. U.S.S.N. 09/358,972, now U.S.P.N. 6,235,480 discloses subject matter carried forward into (1) U.S.S.N. 09/383,316 (now U.S.P.N. 6,391,551), whose restricted and therefore patentably distinct claims are in the co-pending division U.S.S.N. 10/152,297, and its co-pending continuation-in-part U.S.S.N. 09/739,909; (2) U.S.S.N. 09/406,147 (now U.S.P.N. 6,270,974), whose restricted and therefore patentably distinct claims are in co-pending division U.S.S.N. 09/780,863; (3) U.S.S.N. 09/406,065 (now U.S.P.N. 6,312,902); (4) U.S.S.N. 09/430,615 (now

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U.S.P.N. 6,277,578); (5) U.S.S.N. 09/406,064 (now U.S.P.N. 6,270,973), whose restricted and therefore patentably distinct claims are in the co-pending division U.S.S.N. 09/788,847, and its co-pending continuation-in-part U.S.S.N. 09/924,981; (6) U.S.S.N. 09/425,460 (now U.S.P.N. 6,268,146); and (7) co-pending U.S.S.N. 09/396,334. To further aid prosecution, copies of any of the pending or issued claims will be provided at the request of the Examiner.

The assertion that the disclosures of Nelson teach the incorporation of a suitable nucleotide into the 3'-terminus of the nucleic acid hybrid to produce an incorporated modified 3'-terminus within the meaning of the claims at issue is respectfully traversed. The disclosures of Nelson teach the deprotection and chemical modification of an oligonucleotide during solid phase synthesis (using their invention, a 3' primary aliphatic amine linker to controlled pore glass). The disclosures of Nelson et al. "expand the potential application for oligonucleotides as hybridization probes" by providing a synthetic route to making labeled oligonucleotides useful as probes. It is submitted, however, that a worker of ordinary skill in the art would not be motivated to attempt to apply a single strand synthetic technique to a hybrid in the recited pyrophosphorolysis reaction mixture.

In view of the enclosed terminal disclaimer over U.S. Patent No. 6,235,480 B1, it is respectfully

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requested that the obviousness-type double patenting rejection be withdrawn.

B. Claims 24 and 25 stand rejected as being allegedly obvious under the judicially created doctrine of obviousness-type double patenting over claims 1-152 of U.S. Patent No. 6,235,480 B1, in view of the disclosures of U.S. Patent 5,401,837 (Nelson, issued March 28, 1995) and further in view of the disclosures of U.S. Patent No. 6,194,556 B1 (Acton et al., issued February 27, 2001).

The discussion above with respect to U.S. Patent No. 6,235,480 B1 and Nelson apply equally well to this ground for rejection and are incorporated herein by reference, and it is believed that the earlier-filed applications also provide support for the subject claims. The use of a solid support is disclosed in U.S. Patent No. 6,235,480 at column 38, lines 1-13.

It is respectfully submitted that due to the cited passage in the earlier-filed case, there is no need to consider the disclosures of Acton et al., with which the characterization of the disclosures and their applicability here are respectfully disagreed. The disclosures of Acton et al. are directed toward an angiotensin converting enzyme homolog and therapeutic and diagnostic uses thereof. A worker of ordinary skill in the art would not search angiotensin art for guidance on how to attach nucleic acids to a solid support.

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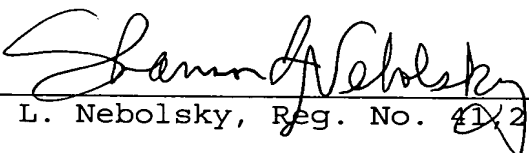
SUMMARY

The bases for rejection of the claims have been dealt with. The application is believed to be in condition for allowance. An early notice to that effect is earnestly solicited.

The fee required under 37 C.F.R. § 1.17(a) for the Petition under 37 C.F.R. § 1.136(a) and the fee required under 37 C.F.R. § 1.20(d) for the Statutory Disclaimer is enclosed herewith. No further fee or petition is believed to be necessary. However, should any further fee be needed, please charge our Deposit Account No. 23-0920, and deem this paper to be the required petition.

The Examiner is requested to phone the undersigned should any questions arise that can be dealt with over the phone to expedite this prosecution.

Respectfully submitted,


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